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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,555	03/29/2004	Ivan Labonte	86421-27	1237
28291	7590	12/29/2006	EXAMINER	
FETHERSTONHAUGH - SMART & BIGGAR			MOHANDESI, JILA M	
1000 DE LA GAUCHETIERE WEST				
SUITE 3300			ART UNIT	PAPER NUMBER
MONTREAL, QC H3B 4W5			3728	
CANADA				
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/29/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/810,555	LABONTE, IVAN	
	Examiner	Art Unit	
	Jila M. Mohandes	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 March 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-41 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-41 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 07-29-04.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means", "comprises" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 10-14, 28-29, 32-33 and 36-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Tawney et al. (U.S. no. 5,885,500). Tawney discloses a lasted footwear for enclosing a human foot, said lasted footwear comprising an outer shell (sidewalls 18, base 20 and foam bootie 24, see column 3, lines 60-63) for receiving the heel, the ankle and the medial and lateral sides of the foot, said outer shell comprising a layer of thermoformed foam, said layer of thermoformed foam comprising first and

second opposite surfaces, one of said first and second opposite surfaces being heat-treated. See Figures 1-10 embodiments and column 4, lines 53-67.

Tawney discloses the method of making a lasted boot for enclosing a human foot, said method comprising: selecting a layer of thermoformed foam having first and second opposite surfaces; heat treating at least one of said first and second opposite surfaces of said layer of thermoformable foam; and thermoforming said layer of thermoformable foam for constructing an outer shell having a foot-receiving cavity with a three-dimensional geometry that conforms to the heel, ankle and medial and lateral sides of the foot.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 3-9, 15-27, 30-31, 34-35 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tawney. With respect to claims 3 and 21, Tawney discloses

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a second layer, foam overlay (34). With respect to the material of the layer, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claims 6-7, 22 and 25, note the foam inner liner (26) having inner and outer surfaces, said inner surface being adapted to contact the foot in use and said outer surface being affixed to said first layer of said outer shell.

With respect to claims 4-5 and 23-24, Tawney discloses a third layer, material surface layer (19) that forms part of said outer surface. With respect to the material of the layer, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claims 8, 16 note the insole/midsole (base 20), see column 5, lines 54-58.

With respect to claims 9, 26, 35 and 40, note outsole (16) in Figure9 embodiment.

With respect to claims 17-18, and 39, note the lower skirts, foam wall 18' which wraps around the lateral side, bottom surface, and medial side of the last 36, therefore eliminating the use of a foam base as shown in figure 8 embodiment.

With respect to claims 15, 19-20, 27, 34, 38 and 41, Tawney discloses that universally-shaped thermoplastic or additional parts such as closure elements, eyelet reinforcements, ankle support devices, forefoot stability supports, etc., may also be

disposed between the foam layers prior to molding process and then formed to the desired shape during the molding process along with the foam core 22. See column 5, lines 59-67 and column 6, lines 1-16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a toe cap, tongue lateral and medial cup-shaped ankle sections to the lasted boot of Tawney to change the performance characteristic of the outer shell depending on its intended use.

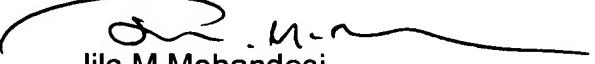
With respect to claims 30-31, the lasted boot of Tawney can be utilized in an ice skate or an inline roller skate.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandes who whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jila M Mohandes  
Primary Examiner  
Art Unit 3728

JMM  
December 18, 2006